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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,888	01/28/2002	Eric Bacque	03806.0474	2049

7590 06/08/2004

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Washington, DC 20005-3315

EXAMINER

KAM, CHIH MIN

ART UNIT PAPER NUMBER

1653

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/055,888	Applicant(s) BACQUE ET AL.	
	Examiner Chih-Min Kam	Art Unit 1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U. S. C. 121:

I. Claims 1-10 and 12, drawn to a group B streptogramin derivative of formula (I) or a salt thereof, a process for preparing at least one group B streptogramin derivative of formula (I), or a pharmaceutical composition comprising at least one group B streptogramin derivative of formula (I), classified in class 514, subclass 9, and class 530, subclass 317.

II. Claims 11 and 13-16, drawn to a pharmaceutical composition comprising at least one group B streptogramin derivative of formula (I), and at least one group A streptogramin derivative or salt thereof, classified in class 514, subclass 9, class 540, subclass 457, and class 514, subclass 375.

Should Group I be elected, applicant is required to elect one (1) group B streptogramin derivative of formula (I) with a defined R, R₁, R₂, R_a, R_b, R_c and R_d group from claim 1. Each group B streptogramin derivative of formula (I), which contains a different substituent group for R, R₁, R₂, R_a, R_b, R_c and R_d, and has different chemical and physical properties, is considered patentably distinct. This is not species election.

Should Group II be elected, applicant is required to elect one (1) group B streptogramin derivative of formula (I) with a defined R, R₁, R₂, R_a, R_b, R_c and R_d group from claim 1 or 16, and one (1) group A streptogramin derivative from subgroup (A), (B), (C) or (D) of claims 14 and 15 with a defined substituent group, e.g., if derivative of subgroup (C) were elected, a further election of R₁ and R₂ group is also

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required; if derivative of subgroup (D) were elected, a further election of R_1 , R_2 and R_3 (further R'_3) group is also required. Each group B streptogramin derivative of formula (I) or each group A streptogramin derivative, which contains a different substituent group and has different chemical and physical properties, is considered patentably distinct. This is not species election. All other group B streptogramin derivatives of formula (I) and/or other group A streptogramin derivatives encompassed by the claims will be withdrawn by the Examiner as being drawn to non-elected invention.

2. The inventions are distinct, each from the other because of the following reasons:

The product of Invention I and the product of Invention II are distinct from each other because they are physically and chemically distinct entities and produce different antibacterial effects, e.g., the product of Invention II shows synergistic action on antibacterial effect (page 4, paragraph [006]), while the product of Invention I does not.

The method of Invention I is distinct from the product of Invention II because the group A streptogramin derivative contained in the product of Invention II cannot produced by the method of Invention I.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by different classification and the recognized divergent subject matter, and because Inventions of I-II require different searches but are not co-extensive, examination of these distinct inventions would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

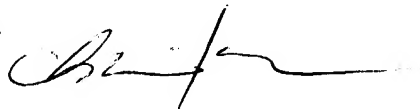
A telephone call was made to Mark Feldstein on June 7, 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571) 272-0951. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D.
Patent Examiner



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June 7, 2004